UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,351	11/26/2003	Arnold M. Lund	8285/664	8066

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PATEL, JAY P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/724,351	LUND, ARNOLD M.
	Examiner	Art Unit
	JAY P. PATEL	2466

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 May 2010</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>31-43</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>31-43</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

5/4/2010 has been entered.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a)   A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to
> which said subject matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

2.   Claims 31-37, 39-41 and 43-44 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Dunn et al. (US Patent 5916302) further in view of Berkley et al. (US

Patent 6546005 B1).

3.   In regards to claims 31 and 34, Dunn et al. (US Patent 5916302) disclose in

figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a

telephone call from a calling party at a telephony network). At step 37, the participants

converse over a PSTN connection (establishing a voice channel configured to facilitate

voice communication between a called party and a calling party over a telephony

network in response to receiving a telephone call from the calling party at the telephony

network; wherein a voice communication between the called party and the calling party

is carried over the voice channel of the telephony network). At step 41 in figure 6a,

image data flows from originating conferee to conference server to other conferees and

is separate from voice (establishment of a data channel to facilitate a data

communication between the called party and the calling party; and the data

communication between the called party and the calling party is carried over the

separate virtual data channel of the packet data network).

4.   In further regards to claims 31 and 34, although Dunn teaches an establishment

of the virtual data channel as between the called party and the calling party, Dunn fails

to teach the data channel being automatically established in response to receiving the

telephone call at the telephony network. Dunn in fact teaches establishing parallel voice

and data connections over physically or logically separate lines extending to the PSTN

and data network (see column 9, lines 51-54), where the establishment of the parallel

data connection is done upon the request of a user (i.e. a manual establishment) (see

column 2, lines 63-67 and column 3, lines 1-3).

5.   In *In re Venner*, the court held that broadly providing an automatic or mechanical

means to replace a manual activity which accomplished the same result is not sufficient

to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958).

6.   Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to establish the data channel automatically instead of manually.

7.   In further regards to claims 31 and 34, Dunn fails to teach determining a configuration of customer premise equipment for the calling party and customer premise equipment for the called party and the establishing of a separate parallel virtual data channel if the configurations are compatible and accessing a database to determine the broadband access capabilities.

8.   Berkley however, teaches the above-mentioned limitations in the active user registry disclosed in figure 2 which is queried anytime a user need to communicate through a packet or a voice network. The database is inclusive of multimedia capabilities 280, LAN and modem IP addresses 260 and URL addresses 270. Furthermore, the calling party is contacted first with a preferred method designated by the party (see column 9, lines 37-46).

9.   Berkeley further teaches as an example in figure 3c that for example, if a subscriber at step 321 initiates a contact using multimedia PC 160. The subscriber at step 323 requests the AUR system to provide a URL for visiting the user's home page and then leaving an email message for the user. The AUR system at step 324 compares the subscriber's request (URL and email message) against the user's preference (e-mail, voice mail or fax) (determining the configuration of the CPE for the called party and calling party). The AUR system selects email since this is common to both user and subscriber (thus, the called party has a compatible configuration to the

calling party and thus the data channel can be established since if a email can be sent,

a data channel must be established) (see column 11, lines 18-54 and figure 3c).

10.   Therefore it would have been obvious to one skilled in the art at the time the

invention was made to incorporate the active user registry taught by Berkley into the

conference server taught by Dunn. The motivation to do so would be to ascertain the

network address to place a conference call.

11.   In regards to claim 32, step 43 in figure 6a of Dunn shows that the data signals

represent displayable images, visual cues to be displayed and service request changes.

12.   In regards to claim 33, at step 41 in figure 6a of Dunn, image data flows from

originating conferee to conference server to other conferees and is separate from voice.

13.   In regards to claim 35, at steps 40 and 41 in Dunn, voice signals and data

images flow between all conferees.

14.   In regards to claim 36, Dunn et al. (US Patent 5916302) disclose in figure 6, a

process 36 for establishing a voice connection through a PSTN (receiving a telephone

call from a calling party at a telephony network). At step 37, the participants converse

over a PSTN connection (establishing a voice channel over the telephony network

wherein the voice channel is configured to facilitate a voice communication between a

called party and the calling party). At step 41 in figure 6a, image data flows from

originating conferee to conference server to other conferees and is separate from voice

(establishment of a virtual data channel to facilitate a data communication between the

called party and the calling party on a packet data network in response to receiving the

telephone call at the telephone network, after the voice conversation begins over the voice channel). If further regards, step 41 in figure 6a states that the image data remains separate from voice throughout their handling to and from the server (wherein the voice channel and the virtual data channel operate in parallel to provide a synchronized voice and data transmission between the calling party and the called party)

15.   In further regards to claim 36, although Dunn teaches an establishment of the virtual data channel as between the called party and the calling party, Dunn fails to teach the data channel being automatically established in response to receiving the telephone call at the telephony network. Dunn in fact teaches establishing parallel voice and data connections over physically or logically separate lines extending to the PSTN and data network (see column 9, lines 51-54), where the establishment of the parallel data connection is done upon the request of a user (i.e. a manual establishment) (see column 2, lines 63-67 and column 3, lines 1-3).

16.   In *In re Venner*, the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

17.   Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to establish the data channel automatically instead of manually.

18.   In further regards to claim 36, Dunn fails to teach determining a configuration of customer premise equipment for the calling party and customer premise equipment for the called party and the establishing of a separate parallel virtual data channel if the configurations are compatible.

19.   Berkley however, teaches the above-mentioned limitations in the active user registry disclosed in figure 2 which is queried anytime a user need to communicate through a packet or a voice network. The database is inclusive of multimedia capabilities 280, LAN and modem IP addresses 260 and URL addresses 270. Furthermore, the calling party is contacted first with a preferred method designated by the party (see column 9, lines 37-46).

20.   Berkeley further teaches as an example in figure 3c that for example, if a subscriber at step 321 initiates a contact using multimedia PC 160. The subscriber at step 323 requests the AUR system to provide a URL for visiting the user's home page and then leaving an email message for the user. The AUR system at step 324 compares the subscriber's request (URL and email message) against the user's preference (e-mail, voice mail or fax) (determining the configuration of the CPE for the called party and calling party). The AUR system selects email since this is common to both user and subscriber (thus, the called party has a compatible configuration to the calling party and thus the data channel can be established since if a email can be sent, a data channel must be established) (see column 11, lines 18-54 and figure 3c).

21.   Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the

conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

22.   In regards to claim 37, step 43 in figure 6a of Dunn shows that the data signals represent displayable images, visual cues to be displayed and service request changes.

23.   In regards to claim 39, at steps 40 and 41 in Dunn, voice signals and data images flow between all conferees.

24.   In regards to claim 40, Dunn et al. disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

25.   In further regards to claim 40, at step 37, the participants converse over a PSTN connection (establishing, over a telephony network via a subscriber loop in communication with the telephony network, a voice channel configured to facilitate a voice communication from a calling party to a called party, in response to receiving a telephone call from the calling part over the subscriber loop wherein the voice channel carries the voice communication over the subscriber loop). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the virtual data channel carries the data communication concurrently over the subscriber loop; where the data channel carries the data communication over the subscriber loop).

26.   In further regards to claim 40, although Dunn teaches an establishment of the virtual data channel as between the called party and the calling party, Dunn fails to

teach the data channel being automatically established in response to receiving the

telephone call at the telephony network. Dunn in fact teaches establishing parallel voice

and data connections over physically or logically separate lines extending to the PSTN

and data network (see column 9, lines 51-54), where the establishment of the parallel

data connection is done upon the request of a user (i.e. a manual establishment) (see

column 2, lines 63-67 and column 3, lines 1-3).

27.   In *In re Venner*, the court held that broadly providing an automatic or mechanical

means to replace a manual activity which accomplished the same result is not sufficient

to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958).

28.   Therefore, it would have been obvious for one of ordinary skill in the art at the

time the invention was made to establish the data channel automatically instead of

manually.

29.   In further regards to claim 40, Dunn fails to teach, determining a data address for

the calling party on a data network and a data address for a called party on the data

network. Berkley et al. however, teach the above-mentioned limitation where a

database is queried in the user registry to ascertain the identification information (see

figure 2, element 260).

30.   In further regards to claim 40, Dunn also fails to teach determining whether a

configuration of the customer premise equipment for the calling party is compatible with

a configuration of customer premise equipment for the called party and the automatic

establishing of a separate parallel virtual data channel including the determining the

configurations of the CPE for the calling and called parties involved and establishing the

virtual data channel if the configurations are compatible.

31.   Berkley however, teaches the above-mentioned limitations in the active user

registry disclosed in figure 2 which is queried anytime a user need to communicate

through a packet or a voice network. The database is inclusive of multimedia

capabilities 280, LAN and modem IP addresses 260 and URL addresses 270.

Furthermore, the calling party is contacted first with a preferred method designated by

the party (see column 9, lines 37-46).

32.   Berkeley further teaches as an example in figure 3c that for example, if a

subscriber at step 321 initiates a contact using multimedia PC 160. The subscriber at

step 323 requests the AUR system to provide a URL for visiting the user's home page

and then leaving an email message for the user. The AUR system at step 324

compares the subscriber's request (URL and email message) against the user's

preference (e-mail, voice mail or fax) (determining if the configuration of the CPE for the

called party and calling party are compatible). The AUR system selects email since this

is common to both user and subscriber (thus, the called party has a compatible

configuration to the calling party and thus the data channel can be established since if a

email can be sent, a data channel must be established) (see column 11, lines 18-54 and

figure 3c).

33.   Therefore it would have been obvious to one skilled in the art at the time the

invention was made to incorporate the active user registry taught by Berkley into the

conference server taught by Dunn and the automatic establishment of a data channel

as taught by Greene. The motivation to do so would be to ascertain the network address to place a conference call.

34.   In regards to claim 43, Dunn teaches in figure 6a, at steps 40 and 41, voice signals and data images flow between all conferees.

35.   In regards to claims 41 and 44, Dunn in combination with Berkley teaches all the limitations of parent claims 40 and 43. Dunn further teaches in figure 6a, at steps 40 and 41, voice signals and data images flow between all conferees (concurrently sharing information over the voice and data channels). However, Dunn fails to teach ascertaining a data address that is an IP address and transmitting the data address of the party to all the attendees. Berkley teaches the above-mentioned limitation where a database is queried in the user registry to ascertain the identification information (see figure 2, element 260) and using the appropriate contact information initiation communications (see figure 3a and 3b, steps 306 and 316).

36.   Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn and the automatic establishment of a data channel as taught by Greene. The motivation to do so would be to ascertain the network address to place a conference call.

37.

38.   Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) in view of Berkley et al. (US Patent 6546005 B1) further in view of Fukuoka et al. (US Patent 5914940).

39.   In regards to claim 38, Dunn in combination with Berkley teaches or is obvious over all the limitations of parent claim 36 as stated above. Dunn teaches at step 40 in figure 6a, voice signals flowing between conferees over the voice channel.

40.   Dunn and Berkley however fails to teach, sending video signals over the virtual data network. Fukuoka however, teaches the above-mentioned limitation in figure 5 step S8 where a composite video packet is sent over a packetized network.

41.   Therefore, it would have been obvious to one skilled in the art at the time the invention was made to allow the transmission of a video packet as taught by Fukuoka in the data network taught by Dunn and Berkley. The motivation to do so would be allow a network user to send video signal in order to enhance the conferencing between all the parties involved.

42.   Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) in view of Berkley et al. (US Patent 6546005 B1) and further in view of DeSimone et al. (US Patent 6138144).

43.   In regards to claim 42, Dunn in combination with Berkley teaches all the limitations of parent claims 40 and 41. Neither Dunn nor Berkley teaches the virtual data channel using an ATM protocol.

44.   DeSimone however, teaches the above-mentioned limitation in figure 1 where a user 101-1 establishes a connection with multicast server 130 using the ATM protocol (see column 7, lines 1-2).

45.   Therefore, it would have been obvious to one skilled in the art at the time the invention was made to use of the ATM protocol as taught by DiSimone to set up the

virtual data channel as taught by Dunn, the active user registry taught by Berkley. The

motivation to do so would be to allow the option of assigning the variable bit rate

services that ATM allows.

Response to Arguments

Applicant's arguments filed on 5/4/2010 have been fully considered but they are

not persuasive.

The applicant argues that more elaboration is needed as far as Berkley is

concerned with respect to the determination of the customer premise equipment of the

calling and called party and comparing them to see if they are compatible and

establishing the virtual data channel if they are compatible. However, the examiner

respectfully disagrees.

Berkeley teaches as an example in figure 3c that for example, if a subscriber at

step 321 initiates a contact using multimedia PC 160. The subscriber at step 323

requests the AUR system to provide a URL for visiting the user's home page and then

leaving an email message for the user. The AUR system at step 324 compares the

subscriber's request (URL and email message) against the user's preference (e-mail,

voice mail or fax) (determining if the configuration of the CPE for the called party and

calling party are compatible). The AUR system selects email since this is common to

both user and subscriber (thus, the called party has a compatible configuration to the

calling party and thus the data channel can be established since if a email can be sent,

a data channel must be established) (see column 11, lines 18-54 and figure 3c).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JAY P. PATEL whose telephone number is (571)272-

3086. The examiner can normally be reached on Mon.-Thurs.: 8:00 a.m.- 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Daniel J. Ryman can be reached on (571)272-3152. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. P. P./
Examiner, Art Unit 2466

/Melanie Jagannathan/
Primary Examiner, Art Unit 2468